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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,051

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Klaus Richard Pawelzik

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PATENT GROUP

MACDONALD, ILLIG, JONES & BRITTON LLP

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SUITE 700

ERIE, PA 16507-1459

EXAMINER

BAYS, PAMELA M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,051	Applicant(s) PAWELZIK ET AL.	
	Examiner Pamela M. Bays	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 10-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>13 November 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 10-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Since there were no accompanying arguments, the Examiner considers that the election was made **without** traverse in the reply filed on 20 October 2009. Thus Claims 1-9 are presently pending in this application.
2. These claims had been previously amended in a Preliminary Amendment dated 15 January 2007.

Drawings

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because no separate properly labeled English-version of the drawings have been filed, for example, the Figures are still labeled "Figur".
4. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. Regarding Claim 1, the limitation "information relating to the identity of said transmitter can be coded in analog fashion in the form of at least one transmission property of said transmitter" is not enabled by the Applicant's Specification, because the scope of what is meant by "identity" is not defined, nor how the identity is determined. Claims 2-9 are rejected for depending on rejected Claim 1.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1-9 are rejected because the claims are generally narrative and indefinite (including "for" and "can be" language), failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Glover (US Patent No. 3,662,758).

13. Regarding Claim 1, Glover discloses a device for implantation in a living being for detecting electrical bioactivity (Abstract) comprising two measuring electrodes (46b, 46c, Fig. 2) for detecting a voltage difference representing bioactivity of tissue of the living being (Abstract, Col. 3, Lines 15-50, Col. 5, Lines 1-20); a wireless transmitter (33, Fig. 2) for transmitting information outside the tissue (Col. 1, Lines 55-75, Col. 5, Lines 1-20), the information relating to the bioactivity as represented by the voltage difference detected by said two measuring electrodes (Abstract, Col. 3, Lines 15-50, Col. 5, Lines 1-20); a wireless energy receiver (30, Fig. 2) for receiving energy from outside the tissue to supply said transmitter with electrical energy (Abstract, Col. 3, Lines 33-65), said transmitter and said energy receiver operating in parallel in time (Abstract, Col. 1, Lines 55-75); and a voltage sensitive switch (32, Fig. 2, Col. 4, Lines 15-65) connected between said two measuring electrodes and said transmitter, said voltage sensitive switch being positioned for switching said transmitter such that information relating to changes in electrical bioactivity can be coded in analog fashion in the form of a change of at least one transmission property of said transmitter (Col. 4, Lines 67 - Col. 5, Line 11), and information relating to the identity of said transmitter (interpreted to mean FM signals transmitted with information) can be coded in analog fashion in the form of at

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least one transmission property of said transmitter (Col. 3, Lines 15-50, Col. 4, Lines 67 - Col. 5, Line 11).

14. Regarding Claim 2, Glover discloses a device further wherein at least one transmission property of said transmitter is a transmit frequency (Col. 4, Lines 67 - Col. 5, Line 11).

15. Regarding Claim 3, Glover discloses a device further wherein said switch being configured such that said switch switches said transmitter to an on condition or an off condition when the detected voltage difference overshoots or undershoots a voltage threshold value which can be fixed in advance ("The impedance of the material between the electrode 46b and 46c dictates the amount of the signal from the free-running multivibrator 52 which will reach the amplifier-transmitter 55", Col 5, Lines 5-10).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. *Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover.*

18. Regarding Claims 4-8, Glover discloses all of the claimed elements as described above, except wherein said transmitter comprises a closed resonant circuit, a

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photodiode, an LED, a quantum well structure, or a quantum line structure. However, the Examiner is taking Official Notice that these transmission means are well-known in the art, and each has advantages and disadvantages. For example, Patent No. 4,541,431 discloses a closed resonant circuit transmission means (Col. 2, Lines 35-50), Patent No. 4,677,982 discloses a photodiode transmission means (Col. 2, Lines 14-25), Patent No. 4,495,384 discloses an LED transmission means (Col. 7, Lines 15-30), Patent No. 6,248,069 discloses a quantum well structure transmission means (Abstract), and US Publication No. 2002/0186727 discloses a quantum line structure transmission means (Paragraph 0044). It would have been obvious to one having ordinary skill in the art at the time of the invention to use any of these transmitters/transmission means to transmit signal data in the device disclosed by Glover.

19. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glover in view of Hochmair et al (US Patent No. 4,357,497).

20. Regarding Claim 9, Glover discloses all of the claimed elements as described above, except wherein further comprising at least two transmitters that can be distinguished on the basis of different transmission properties. However, Hochmair et al discloses an implantable device with multiple transmitters operating on different channels to transmit data to an external receiver (Abstract, Channels 1, 2, etc, Fig. 10). It would have been obvious to one having ordinary skill in the art at the time of the invention to use multiple transmitters operating on different channels as taught by Hochmair et al in the implantable device disclosed by Glover in order to simultaneously transmit data with different information from different areas.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gord et al (US Patent No. 5,876,425) discloses an implantable device with an power control loop for external powering, along with transmission and receiving means (Abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela M. Bays whose telephone number is (571) 270-7852. The examiner can normally be reached on Monday-Friday, 9am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl H. Layno/
Supervisory Patent Examiner, Art Unit 3766

/P. B./
Examiner, Art Unit 3766